

## **REMARKS**

Applicants have canceled claims 1 and 2 without prejudice or disclaimer of their subject matter, amended claims 3, 5, 14, and 16 into independent form, amended claims 7-9 to change their dependencies, amended claim 10 to more appropriately define the present invention, amended claims 13 and 18 solely to correct grammar by inserting a “comma,” and added new claims 21-28 to protect additional aspects related to the present invention. Claims 3-28 are pending and under current examination.

### **Regarding the Office Action:**

In the Office Action, the Examiner rejected claims 1, 2, 7, 8, 10-13, 18, and 19 under 35 U.S.C. § 102(e) as anticipated by Mueller, et al. (U.S. Patent No. 6,435,947) (“Mueller”); rejected claims 9 and 20 under 35 U.S.C. § 103(a) as unpatentable over Mueller; and objected to claims 3-6 and 14-17 as being dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants traverse the objection and rejections for the following reasons.<sup>1</sup>

### **Regarding the Claim Amendments and the Objection to claims 3-6 and 14-17:**

In response to the Examiner’s objection, Applicants have rewritten claims 3, 5, 14, and 16 into independent form. Claims 7 - 9 have been amended to be dependent from claim 3. This leaves claims 4 and 7-9, claims 6, 21-23, and 28, claims 15 and 27, and claim 17 to depend from one of claims 3, 5, 14, and 16, respectively. Therefore Applicants deem claims 3 -9, 14-17, 21-23, 27, and 28 allowable.

---

<sup>1</sup> The Office Action contains statements characterizing the related art, case law, and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Applicants have amended claim 10 to add the element "...wherein the fluid does not contain oxidants." Support for this amendment may be found in the specification on page 11, lines 6-16, for example. Furthermore, new claims 24-26 depend from claim 10; and support for the new claims may be found in the specification at, for example, page 10, line 24 to page 11, line 3, and on page 11, lines 12-17.

**Rejection of Claims 1, 2, 7, 8, 10-13, 18, and 19 under 35 U.S.C. § 102(e):**

The rejection of claims 1 and 2 has been rendered moot by the cancellation of these claims, without prejudice or disclaimer of their subject matter. The rejection of claims 7, 8 is also moot, because claims 7 and 8 are allowable at least by virtue of their dependence from allowable base claim 3, for the reasons presented above.

In order to properly establish that Mueller anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Mueller does not disclose each and every element of Applicants' claimed invention, despite the Examiner's allegations. Applicants independent claim 10 recites, among other things, "...a fluid interposed between the polishing member and the surface of the workpiece ..., wherein the fluid does not contain oxidants."

In contrast, Mueller discloses that

In a further embodiment, this invention is a method for polishing a substrate surface including at least one metal portion. The method includes the

steps of preparing a polishing pad by incorporating at least one heterogeneous solid catalyst into a polishing pad substrate. Once prepared, *the polishing pad is then, in the presence of a solution including an oxidizing agent, brought into contact with the substrate surface* after which at least a portion of the substrate surface metal portion is removed by moving the polishing pad in relation to the substrate.

*See Mueller*, col. 3, lines 53-62, italics added. Therefore, since Mueller clearly discloses a solution including an oxidizing agent, Mueller does not disclose that “the fluid does not contain oxidants” (claim 10).

Thus, Mueller does not disclose at least the above-quoted elements of claim 10. Mueller therefore does not anticipate Applicants’ claims 10-13, 18, and 19, and the Examiner has not met the essential requirements of anticipation for a proper 35 U.S.C. § 102(e) rejection. Independent claim 10 is allowable, for the reasons argued above, and dependent claims 11-13, 18, and 19 are also allowable at least by virtue of their dependence from allowable base claim 10. Therefore, the improper 35 U.S.C. § 102(e) rejection of claims 10-13, 18, and 19 should be withdrawn.

**Rejection of Claims 9 and 20 under 35 U.S.C. § 103(a):**

The rejection of claim 9 is moot, because claim 9 is allowable at least by virtue of its dependence from allowable base claim 3, for the reasons presented above.

Applicants respectfully traverse the rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Mueller. Applicants disagree with the Examiner’s arguments and conclusions. A *prima facie* case of obviousness has not been established.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

At least the first requirement for establishing a *prima facie* case of obviousness has not been established, because Mueller does not teach or suggest each and every element of claim 20. In the previous section of this Amendment, Applicants established that Mueller does not teach or suggest Applicants' claimed "...a fluid interposed between the polishing member and the surface of the workpiece ..., wherein the fluid does not contain oxidants," which appears in independent claim 10 from which claim 20 depends. Moreover, the Examiner admitted that Mueller "does not disclose that a concentration of the photocatalyst particles in the member falls within a range of 10% by volume to 90% by volume [claim 20]" (Office Action, p. 3).

Therefore, the Examiner's application of Mueller does not satisfy the tenets of a proper 35 U.S.C. § 103(a) rejection. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, [...]. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, [...]" M.P.E.P. § 2143.03, internal citations omitted. The Examiner has not met an essential criterion for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See M.P.E.P. §§ 2142 and 2143. Claim 20 is allowable for the reasons presented above, and at least by virtue of its dependence from allowable base claim 10. Therefore, the improper 35 U.S.C. § 103(a) rejection should be withdrawn.

**Conclusion:**

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the objection and rejection. Pending claims 3-28 are in condition for allowance, and Applicants request a favorable action.

Should the Examiner continue to dispute the patentability of the claims after consideration of this Amendment, Applicants encourage the Examiner to contact the undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 26, 2004

By:   
David M. Longo  
Reg. No. 53,235

/direct telephone: (202) 408-4489/